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180 NORTH LASALLE STREET  
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| EXAMINER |
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HOEL, MATTHEW D

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| ART UNIT | PAPER NUMBER |
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3714

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04/04/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/825,490 | <b>Applicant(s)</b><br>JOHNSON, BRADLEY W. |  |
|                              | <b>Examiner</b><br>Matthew D. Hoel   | <b>Art Unit</b><br>3714                    |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 40,42-59 and 82-87 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 40,42-59 and 82-87 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

2. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

4. Determining the scope and contents of the prior art.
5. Ascertaining the differences between the prior art and the claims at issue.
6. Resolving the level of ordinary skill in the pertinent art.
7. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. **Claims 40, 40, 43, 46, 48 to 51, 54 to 59, 82 to 84, and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brosnan et al., U.S. Patent No.**

**6,656,040 B1 in view of Astaneha, U.S. Patent No. 6,302,395 B1, and further in**

**view of Ungaro, et al. (U.S. pre-grant publication 2003/0036426 A1, application**

**09/799,889).** Brosnan discloses a gaming comprising a one round of a first game of

chance having a first game outcome. The first game of chance allows the player to

place a first wager at a game player position and potentially entitling the player to a first

prize if a winning outcome occurs (See Brosnan col. 4 lines 25-42; Fig. 4 & 7). The first

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game of chance has a first game play area and includes a first wagering scheme, at least two individual card wagering positions and a first wager input (See Brosnan col. 4 lines 54-67). For example, the player may play two poker games in parallel and therefore there would be two individual card-wagering positions. A second game of chance has a second game play area and has a second game outcome. The second game of chance allows the player to place a wager and potentially entitling the player to a second prize if a winning outcome occurs. The second game of chance comprises, a second wagering scheme, a second game player area and a second wager input (See Brosnan col. 4 lines 25-67; Fig. 4; 7) [claims 40, 56]. The first game outcome and the second game outcome are independent (See Brosnan col. 3 lines 45-50) [claims 40, 51]. Brosnan teaches an area on the horizontal top surface of the playing table for playing cards (Figs. 1 & 3, 6:50-55), as presently claimed [Claims 40, 56, 82].

Regarding the new limitation of Claims 40, and 56 Brosnan ('040) teaches the first and second game outcomes not being combined to provide an outcome separate from the first and second game outcomes (Fig. 7; 15:29-16:13, esp. 15:50-65). The award of the first prize is independent of the second game outcome and the award of the second prize is independent of the first game outcome (See Brosnan col. 3 lines 45-50) [claim 42]. The player may wager on either or both of the first and second games of chance (See Brosnan col. 8 lines 22-39; Fig. 7) [claim 48]. The first and second games of chance are operatively coupled to each other (See Brosnan Figs. 1 & 4) [claim 49]. The second game can have more than two outcomes (See Brosnan col. 3 lines 65-67; col. 4 lines 1-4) [claim 54]. For example in poker, one could have a pair, or a flush, etc. The

second game can also be keno (See Brosnan col. 4 lines 1-4) [claim 55]. The first game play area is a card wagering layout area where at least one card is dealt to the player (See Brosnan col. 3 lines 65-67; Fig. 4) [claim 57]. For example, poker can be played. The player is allowed to place a wager on the second game of chance regardless of whether the player placed a wager on the first game of chance (See Brosnan col. 4 lines 25-67; Fig. 7). The player is allowed to place a wager on a first game of chance having a first chance outcome by allowing the player to place a wager on a discrete card game layout the wagering scheme may be poker (See Brosnan Fig. 4). The player is allowed to place a wager on a first wagering scheme and the step of allowing the player to place a wager on a second game of chance having a second game of chance outcome comprises allowing the player to place a wager on a second wagering scheme. The second wagering scheme being distinct from the first wagering scheme (See Brosnan col. 4 lines 25-67; col. 8 lines 22-39; Fig. 7).

9. Brosnan lacks in disclosing a table, a live dealer position and the game of roulette. Astaneha teaches of a combination, dice, card and roulette gambling game. Players play parts of either two or all three games on the same gaming table. The table has a live dealer position and first card wagering positions for the first game of chance at the table. The games are conducted by a live dealer (See Astaneha col. 4 lines 31-48; col. 6 lines 50-67; col. 7 lines 1-2; Fig. 3) [claims 40, 50, 51, 56, 61]. At least one card is dealt to the player (See Astaneha col. 6 lines 50-53) [claim 62]. Astaneha teaches wagering card positions and the second game play area (roulette wheel, roulette being the second game) being mounted on a table (Fig. 1). It would have been

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obvious to one of ordinary skill in the art at the time the invention was made to play the games of Brosnan at a gaming table simultaneously with a live dealer running the games. It has been well known throughout the art that casino games may be played at gaming tables with dealers. Astaneha clearly shows that more than one type of game can be played at a gaming table at one time. Therefore, by playing the plurality of games of Brosnan at a gaming a table simultaneously, players are not bored after a short time and therefore they will not retire from the game, as quickly which is desirable to the casino. Players also enjoy the personal contact with a live dealer versus an electronic machine. Furthermore, by playing multiple games at the same time, the amount of money a casino receives in wagers increases, make the combination of games playable together more profitable for the casino. Astaneha further discloses that a second game play area is a roulette betting area that is located between the dealer position and the card wagering position (See Astaneha Fig. 1) [claims 43, 58]. The roulette wheel is mounted adjacent to the roulette betting area (See Astaneha Fig. 1; col. 6 lines 22-26) [claim 59]. The second game is roulette in which the dealer rotates the wheel (See Astaneha col. 6 lines 22-26) [claim 46]. The player may wager on the second game of chance by allowing the player to place a wager on a discrete wheel game-betting layout (See Astaneha col. 6 lines 22-26) [claim 68]. The roulette wheel is spun and stopped (See Astaneha col. 6 lines 22-26). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have one of the secondary games of Brosnan be roulette. Roulette is a popular casino game that many players enjoy. Consequently, by including roulette as the secondary game, many more

people would desire to play the game. It is further obvious to use a video display to display the roulette wheel, just as it is well known throughout the art to convert electronic games to table games it is just as obvious to convert table games to electronic games. Therefore, it is obvious to use an electronic video display for the wheel as one would in Brosnan. Some players enjoy the electronic displays while others enjoy actual wheels; therefore, by using both, one can appeal to both types of individuals. Concerning the limitation of Claim 40 and 56 of a game having a game display located adjacent to the dealer position, the game display being adapted to display the second game outcome, and a controller being in communication with the game display, the controller being adapted to control the game display—the combination of Brosnan and Astaneha would inherently have this as discussed in the response to the applicant's arguments. Astaneha in Col. 4, Lines 38 to 41 discloses "...a rotatable wheel to be rotated by a dealer and positioned adjacent the dice table, the rotatable wheel having a plurality of segmented areas with different numbers thereon..." (Fig. 1). This rotatable wheel is in a position adjacent to the dealer's position as the roulette wheel is spun by the dealer. In the video game format resulting from the 103 combination with Brosnan, there would be display controlled by a controller that is adjacent to a dealer position, as the dealer position and the roulette reel would both be shown on adjacent displays or shown adjacent to each other on the same display. Further, It would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied this vertically disposed game display of '326 to the combination of '040 and '395. Ungaro, however, discloses a vertically disposed game

display connected to the top surface (54, Figs. 1 & 10; Fig. 3, 30) [claims 40, 56, 82].

The vertically disposed display makes no difference in the play of the game or its outcome, and is merely physical structure that does not directly related to how the games of Astaneha ('395) or Ungaro ('326) are actually played. For one, the vertically disposed display would have had the advantage and effect of making the game outcomes more visible to the players and spectators of the game. It would also have the advantage of providing the roulette game in a format familiar to players of roulette. Also, these types of vertical displays were widely known to be applied to roulette games at the time the invention was made, so one of ordinary skill in the art would have been motivated to apply such a display to a roulette game. '326 discloses a control on the horizontal surface for playing the second game of chance displayed on the vertically mounted display (player control panel 64, Figs. 1 & 13; support found on Page 8 and Figs. 1 to 4 of provisional application 60/196,113 filed on 4-11-2000) [claim 83]. The display device of '326 for playing the second game of chance (roulette) is mounted to the table by a pole connected to one end of the table (Fig. 1, 54; Fig. 3, 30) [claim 84]. '040 discloses the keno games being on vertical displays (Para. 17, Figs. 1 & 4) [claim 87].

10. **Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brosnan et al., in view of Astaneha and Ungaro, in further view of Huard et al., U.S. Patent No. 5,743,800.** The combination of Brosnan, Astaneha, and Ungaro lack in specifically disclosing that the first game is blackjack. Huard teaches of a first game of blackjack that has an auxiliary game. The first wagering scheme is a blackjack-betting



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layout (See Huard et al. col. 2 lines 50-55; col. 5 lines 1-33) [claim 45]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have blackjack be the first game of chance. Blackjack is a very popular casino game and would entice numerous players to play the game as well as the secondary game.

11. **Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brosnan et al., in view of Astaneha and Ungaro, in further view of Adams, U.S. Patent No. 5,911,418.** The combination of Brosnan, Astaneha, and Ungaro lack in disclosing requiring a player to wager on both the first and second games of chance. Adams teaches of a card game with a second game of chance. In order to play the second game of chance, i.e. spin the wheel, the player must have wagered on both the first game and second game (See Adams col. 2 lines 51-67) [claims 47]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to require a player to bet on both games of chance. By requiring a player to bet on both games of chance, the casino makes more money since more bets are being placed. Therefore, it is profitable to have players bet on multiple games.

12. **Claims 44, 51 to 53, 85, and 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brosnan et al., in view of Astaneha and Ungaro, in further view of Pohanka, U.S. Patent Des. 273,310.** The combination of Brosnan, Astaneha, and Ungaro lack in disclosing a wheel rotating about a horizontal axis or that the roulette betting area comprises a video display. Pohanka teaches of an electronic roulette game housing in which the rotatable wheel is mounted to the machine such that it may rotate about a horizontal axis and the roulette betting area comprises a video display

(See Pohanka Fig. 1) [claims 44, 52, 53, 85, 86]. Pohanka also teaches a roulette or rotatable wheel located above a video screen on a video gaming device [claim 51]. The combination of Brosnan, Astaneha, Ungaro, and Pohanka would thus have a roulette or rotatable wheel located above the roulette betting area, table, and first and second game play areas. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the wheel in Astaneha rotate about a horizontal axis. By rotating the wheel about a horizontal axis, the wheel would be clearly visible to more players since they would not have to gather around the wheel to see the outcome. Therefore, more people would be able to see the outcome of the game. It is also obvious to use a video display for the roulette betting area. By using a video display, bets can be processed electronically so that the dealer can concentrate on other functions of the game instead of the betting and it can be assured that the bets are accurately recorded.

### ***Response to Arguments***

13. Applicant's arguments filed 1-4-2008 have been fully considered but they are not persuasive. The examiner's "Response to Arguments" of 2-24-2006, 11-2-2006, 5-9-2007, and 10-9-2007 are incorporated by reference. Regarding the new limitations, Brosnan ('040) outlines first and second game outcomes not being combined to provide an outcome separate from the first and second game outcomes (Fig. 7; 15:29-16:13, esp. 15:50-65). The secondary Astaneha reference was relied upon for the roulette and card games which are capable of being played on screens. While the independent outcomes are supported by the specification, they are a negative limitation, and are not

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patentably distinct over Astaneha's combined bets that the applicant is referring to in his remarks, for example, Astaneha (8:7-15). A game outcome based on the result of two otherwise independent games is merely a bonus or a jackpot outcome meant to entice players to play. Having two independent outcomes with no further secondary outcome is a negative limitation (though supported by the applicant's specification); leaving out the secondary game outcome would merely make the game more "standard" and this aspect of Astaneha was not relied upon anyway. The examiner finds that motivation to make this modification can be found in the prior art. Caro in U.S. patent 5,636,838 A teaches two concentric roulette wheels and two separate betting areas allowing the player make two separate wagers in two separate wagering areas, each wager having outcomes independent of each other (Abst.; Figs. 1 & 4; 1:25-56), nearly identical to the claimed limitations of Claim 1, further including the limitations added by Astaneha: the table (Fig. 4), roulette wheel (Fig. 1), and a dealer position. The applicants appear to be objecting to the combination of Brosnan and Astaneha. The examiner has reviewed the combination; the features relied upon in Brosnan were the parallel game, not the placing of plural parallel games on the same video screen. Brosnan and Astaneha were both analogous art in that the both disclose parallel games of different types being played on the same surface, be it a table or a video screen. The presently claimed vertically mounted display still does not teach away from the combination of Brosnan and Astaneha would have resulted in a playing table with parallel games and automated player wagering areas along the lines of those of Ungaro (items 64, Figs. 1 & 13 of '326). Ungaro ('326) thus provides further motivation to combine Brosnan and Astaneha

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as well as the presently claimed vertically mounted display area. Both references can play parallel games of cards and roulette as disclosed in both references. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The applicants appear to believe that there is no suggestion to combine the references; the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The examiner respectfully disagrees with the applicants as to the claims' condition for allowance.

***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

15. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew D. Hoel whose telephone number is (571)272-5961. The examiner can normally be reached on Mon. to Fri., 8:00 A.M. to 4:30 P.M.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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